

Serial No. 09/715,439
Attorney Ref. No. 1205-002/JRD
Reply to Office Action Dated January 12, 2005

REMARKS

A non-final Office Action, dated January 12, 2005, rejects pending claims 1-61. Reconsideration is respectfully requested in light of the following remarks.

Clarification of earlier claim amendment

Claims 1, 24, and 25 were amended in the third amendment submitted with this application. The fourth amendment properly labeled these claims as "previously presented" but failed to remove the bracketed deleted text. These claims and their current status are properly presented in this amendment.

35 USC § 103

Applicants respectfully traverse the examiner's rejection of claims 1-61 as somehow being rendered obvious by the references of record.

As explained more fully nearly 5 years ago in the specification of the present application, retail pharmacy tracking and error prevention can be vastly improved by incorporating inexpensive technology that before had been limited to use in other areas. Applicants were the first to suggest using the following hardware combinations:

1. Using Radio Frequency Identification Tags in a retail pharmacy to track prescription orders; and,
2. Using Multiplexed tag readers in a retail pharmacy.

Quite simply, NO references of record teach or suggest using this combination of hardware in a retail pharmacy for these purposes. Accordingly, these claims should be allowed.

More significantly, applicants have designed a pharmacy tracking system that significantly improves the speed, accuracy, and ultimate safety of retail pharmacies. Armed only with off-the-shelf components. In a world where retail pharmacies are frequently facing multi-million dollar judgments for dispensing the wrong prescription to a customer and armed only with off-the-shelf components, applicants have invented a pharmacy system that among other benefits is capable of:

1. "Automatically" detecting the presence of a specific filled prescription order therein (Claims 1; 9, & 57);

Serial No. 09/715,439
Attorney Ref. No. 1205-002/JRD
Reply to Office Action Dated January 12, 2005

2. "Automatically" associating that specific filled prescription order with a customer (Claim 1);
3. "Automatically" tracking upstream movement of that specific prescription order as it moves through the pharmacy (Claim 3);
4. "Automatically" evaluating worker performance based on detected timing information compiled by the computer system (Claims 4, 5, 7, & 19);
5. "Automatically" verifying that a pharmacy worker has removed the correct prescription order for a particular customer (Claims 52; 57);
6. "Automatically" signaling a pharmacy worker if an incorrect prescription order is about to be dispensed to a customer, BEFORE it is actually dispensed to that customer (Claim 52); and,
7. Allowing the pharmacy worker to select any storage area for placing in a filled prescription order therein and still allowing the computer system to locate that filled prescription order (Claim 59);

Even if there were references teaching or suggesting using the combination of off-the-shelf components as described by the applicants in a retail pharmacy, there is no teaching or suggestion to USE these components in the manner described to provide the above-referenced benefits in a retail pharmacy.

This application has been pending for nearly 5 years based primarily on the examiners' continuing reliance on U.S. Pat. No. 6,464,142 to Denenberg ("Denenberg"), a reference that teaches having a pharmacy worker break a light beam in a will-call storage system as a proxy for detecting the presence of a specific filled prescription stored therein. Dannenberg's disclosed hardware for accomplishing its limited disclosed processes cannot be configured to produce a pharmacy system that provides ANY of the above-listed features as currently claimed in the pending claims. Instead, as previously noted in applicants' earlier amendments, like other pharmacy systems before it, Denenberg's structure still relies on a worker performing flawlessly on every transaction. In practice, these worker errors, which are ignored by Denenberg's and other systems, give rise to grave consequences.

Accordingly, applicants respectfully traverse the examiner's continuing reliance on Denenberg as a cornerstone of his obviousness rejections. As applicants best

Serial No. 09/715,439
Attorney Ref. No. 1205-002/JRD
Reply to Office Action Dated January 12, 2005

understand the examiner's position, the examiner is taking off the shelf hardware, such as the RFID system disclosed in U.S. Pat. No. 6,496,806 to Horwitz ("Horowitz") and arbitrarily installing it in Denenberg's system. Although there is no teaching or suggestion in any reference of record to combine such structures, applicants maintain that even if there were, the above-listed functions could still not be performed by combining such structures.

For example, Horowitz teaches combining a plurality of RFID tags into a cluster and tracking that cluster to locate an item presumably within that cluster. (See Horwitz, FIG. 1, elements 24 and 34). Such a system would be useless in a pharmacy, where INDIVIDUAL prescription orders must be quickly and easily tracked and located without requiring a worker to identify and select a particular filled prescription order from a cluster of filled prescription orders.

Similarly, the Denenberg system would still identify the will-call storage compartment in which to place a filled prescription. The worker would not be able to select the location. Denenberg's system would still assume that the pharmacy worker will complete each transaction without error.

Also, notwithstanding the examiner's continuing assertion to the contrary, neither Denenberg nor Horowitz teach or suggest verifying that the correct prescription order has been dispensed to the correct customer. The section of Denenberg relied on by the examiner as support for this assertion (Column 10 lines 5-18 and 37-62), simply discloses using customer identification information to allocate a storage location for that customer. There is no teaching in this reference to have that system verify that the correct filled prescription order for that customer has been removed from the storage area, nor could there be because Denenberg neither teaches nor suggest suitable structures to allow such a task.

Accordingly, claims 1-61 should be allowable.

**"OBVIOUSNESS" NOT ADEQUATE GROUNDS TO
REJECT SECONDARY CONSIDERATIONS**

Applicants respectfully traverse the examiner's refusal to consider the previously submitted evidence of commercial success, long felt need, and copying on the grounds that "the prior references disclosed all the limitations as required by the claims and sufficient motivation is provided by the Examiner."

Serial No. 09/715,439
Attorney Ref. No. 1205-002/JRD
Reply to Office Action Dated January 12, 2005

As Applicants best understand this ground for rejection, the Examiner has refused to consider the submitted evidence because he has found the invention "obvious." However, secondary considerations, such as proof of commercial success, long felt need, and evidence of copying, overcome a prima facie rejection under 35 USC Sec. 103. (See MPEP 716.01 (B) and 2141).

"Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as 'the declaration lacks technical validity' or 'the evidence is not commensurate with the scope of the claims' without an explanation supporting such findings are insufficient." (MPEP Sec. 716.01 (B)) Accordingly, Applicants respectfully request clarification as to why the prima facie rejection under USC Sec. 103 has not been overcome by the secondary considerations of record.

Applicants maintain that the previously submitted evidence satisfies the necessary proof requirements of MPEP 716, and it overwhelmingly establishes the non-obviousness of the invention as currently claimed. To facilitate examiner review, a summary of this evidence is re-presented below:

1. Evidence of Long-Felt Need That Was Recognized, Persistent, and Not Solved by Others.

The best example of the need for better prescription order tracking and will-call retrieval can be found by conducting a brief search of recent judgments against pharmacies for distributing the wrong prescription to customers. For example, a jury recently awarded a customer of Wal-Mart Stores, Inc. over \$800,000 in damages for accidentally giving that customer the filled prescription order of another customer who had the same last name. A copy of the court ruling affirming that judgment is attached to the concurrently filed Declaration of Stephen Garrett.

The issue of pharmacies distributing incorrect prescription orders to customers has been around for a long period of time. For example, a scene in the classic 1946 film "It's A Wonderful Life" focuses on the main character, George Bailey, correcting a mistake of the pharmacist that would have resulted in a customer receiving the wrong prescription order.

Yet, despite this long felt need to correct this problem and the prior attempts of others to correct it, many customers are still inadvertently being given the wrong prescription orders.

Serial No. 09/715,439
Attorney Ref. No. 1205-002/JRD
Reply to Office Action Dated January 12, 2005

The present invention successfully corrects this problem by performing at least one, and preferably all, of the following steps:

- a. automatically tracking a filled prescription order throughout the pharmacy (claims 1, 9, and 57);
- b. automatically tracking a customer's filled prescription within a storage area (claim 24);
- c. providing a storage are with individual storage areas, with each one having a unique identifier (claim 31);
- d. tracking a filled prescription order to a specific, worker elected, individual storage area (claim 44), wherein the visual identifier for that storage area is not related to information contained within the customer information (claims 46-47);
- e. automatically verifying that a particular prescription order removed from a particular individual storage area is the correct prescription of the customer seeking to pick-up his or her prescription order (claim 52).

Since there has been a long-felt need for the present invention, and that need was recognized and persistent, but since others did not solve that need prior to the present invention, applicants maintain that the references of record cannot be interpreted so as to render the present invention obvious.

2. Commercial Success

Applicants respectfully traverse the examiner's 35 USC § 103 rejections of claims 1-61 on the grounds of applicant's commercial success derived from the claimed invention under MPEP §716.03. Evidence in support of applicants' commercial success is provided in the attached declaration of Stephen Garrett dated September 30, 2004.

As Mr. Garrett's declaration states, assignee of record, GSL Solutions, Inc. was a start-up organization with little funding and no customers entering a field dominated by a handful of well-funded, large manufacturers. At the time GSL Solutions, Inc. introduced its automated tracking and will-call storage and retrieval system, no pharmacy equipment manufacturer offered the benefits of GSL Solutions, Inc.'s system.

Despite the short time since GSL Solutions, Inc. has been in business, its limited size and resources, and numerous obstacles resulting from having an industry dominated by a hand-full of well-financed and well-connected manufacturers, GSL

Serial No. 09/715,439
Attorney Ref. No. 1205-002/JRD
Reply to Office Action Dated January 12, 2005

Solutions, Inc., and its one product -- the claimed invention, have had numerous sales and have grown to become a viable and competitive pharmacy equipment manufacturer.

In the present case, GSL Solutions, Inc.'s success cannot be attributed to its already existing status in the industry or to its superior sales forces or advertising. It has become successful in such a short time despite its initial weak position in the industry.

A particular high point in GSL Solutions, Inc.'s success to date is the fact that a commercial embodiment of the structure disclosed in U.S. Pat. No. 6,464,142 to Denenberg et al. has proven problematic for its customer, who has elected to replace it with GSL Solutions, Inc.'s system. (See Declaration of Stephen Garrett, paragraphs 2, 9 & 10.)

When pharmacies are facing multi-million dollar lawsuits over improperly dispensing filled prescription orders from an overstuffed and error prone will call storage system, and the dominant pharmacy equipment manufacturers are more interested in selling expensive, complex machinery than solving this problem for its customers, GSL Solutions, Inc.'s commercial success underscore the value of its system and offers further evidence of the non-obviousness of the present invention.

3. Evidence of Copying

"Another form of secondary evidence which may be presented by applicants during prosecution of an application . . . is evidence that the competitors in the marketplace are copying the invention instead of using the prior art. " MPEP § 716.06.

"Copying is an indicium of nonobviousness, and is to be given proper weight." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679, 7 USPQ2d 1315, 1319 (Fed. Cir. 1988).

As noted in the declaration of Stephen Garrett, at least one large, well-funded pharmacy equipment manufacturer was specifically shown the GSL Solutions, Inc. system in operation, and was specifically asked by a customer to copy it. Shortly thereafter, that customer purchased the large, well-funded, pharmacy equipment manufacturers' copied system. (See Declaration of Stephen Garrett, paragraphs 12-14.)

This copying further underscores the non-obviousness of the present invention.

Serial No. 09/715,439
Attorney Ref. No. 1205-002/JRD
Reply to Office Action Dated January 12, 2005

In light of the fact that there had been a unresolved long felt need for GSL Solutions, Inc.'s system, GSL Solutions, Inc. is enjoying commercial success for its system, and its competitors have attempted to copy its system, applicants maintain that this evidence supports a finding that the present invention cannot be rendered obvious by any combination of the references.

CONCLUSION

Applicants continue to maintain that the references of record neither teach nor suggest the combination of elements set forth in the claims of the currently pending application. Even if they did, the evidence of copying, commercial success, and long felt need overcome any such issue.


Given the fact that 1) this case has been pending for nearly five years, 2) applicants have submitted a wide variety of claim sets, each with increasingly narrow claims, not even the narrowest of which has been allowed; and 3) entire claims sets have been rejected for years without any art ever being cited against them until only recently, it appears likely that this matter is headed for an appeal before meaningful examination can be obtained. Applicants respectfully request that the examiner use this opportunity to reconsider his rejections so that applicants can avoid the time and expense of pursuing an appeal.

In view of the foregoing, applicants submit that all of the currently pending claims are in condition for allowance, and respectfully request that the case be passed to issuance. If the Examiner has any questions, he is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,

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By


John R. Dawson
Registration No. 39,504

ipsolon llp
805 SW Broadway # 2740
Portland, Oregon 97205
Phone No. (503) 419-0702
Fax No. (503) 249-7068
E-Mail: john@ipsolon.com